

REMARKS

Claims 1, 4, 5, 7-11, 14, 15 and 20-30 are pending, with claims 1 and 28 being independent. Claims 1 and 22 have been amended and claim 30 has been added. Support for the amendment to claim 1 and new claim 30 can be found in the specification as originally filed, for example, at page 12, lines 17-23. Reconsideration and allowance in view of the above amendments and following remarks are respectfully requested.

Claim Rejections – 35 U.S.C. § 103**- I -**

Claims 1, 4, 5, 7-11, 14, 15 and 20-28 stand rejected under 35 U.S.C. §103(a) as allegedly unpatentable over U.S. Patent No. 6,777,152 ("Konya") in view of the *Handbook of Imaging Materials*, 2nd Edition, by Diamond, pages 202-203 ("Diamond") and further in view of U.S. Patent No. 6,096,468 ("Ohno"). The rejection is respectfully traversed.

Claims 1, 2, 4, 5, 7-11, 14, 15 and 20-27

Amended independent claim 1 recites a toner comprising toner particles that are manufactured by a wet granulating method and contain a binder resin and a colorant and an external additive comprising hydrophobic inorganic fine particles selected from the group consisting of silica, titanium oxide, alumina, zinc oxide, and mixtures thereof and composite oxide fine particles having a specific surface area of not more than 300 m²/g, each of the composite oxide fine particles contain a Si atom and at least one atom of a metal selected from the group consisting of Ti, Zr, Fe, Nb, V, W, Sn and Ge. The toner particles have an average degree of roundness of not less than 0.950.

Konya discloses a pulverizing method for producing toner particles. The Examiner acknowledges that Konya "does not specify a wet granulation method for formation of the

toner particles". (Office Action, Page 2). Diamond is cited as teaching "that a latex aggregation toner formation (i.e., wet granulation . . .) method has become increasingly desirable". (Office Action, Pages 2-3). Ohno is cited as teaching "that toners having a roundness (i.e., circularity) of 0.950 to 0.995, more preferably 0.970 to 0.990 having improved transfer performance and are useful in development of low potential latent images". (Office Action, Page 3).

The Examiner has allegedly provided reasons why one of ordinary skill in the art would have been motivated to modify Konya in view of Diamond and further in view of Ohno to achieve the claimed invention. However, the Examiner has failed to identify where in the prior art one of ordinary skill would have found a disclosure or suggestion which would have led him to make the proposed modification. *See In re Kotzab*, 27 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) (particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected the components for combination in the manner claimed). The absence of particular findings as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected the components for combination in the manner claimed in support of the rejection of claims 1, 4, 5, 7-11, 14, 15 and 20-27 renders the rejection improper.

An adequate showing of motivation to combine requires evidence that a person of ordinary skill in the art would, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. *Ecolochem Inc. v Southern Calif. Edison Co.*, 227 F.3d 1361, 1375, 56 USPQ2d 1065, 1075 (Fed. Cir. 2000) (quoting *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998)). In the present case, the Examiner has not show that the skilled artisan confronted with the problem of degradation

in charging stability, with respect to environmental fluctuations and continuous use, as a result of a required high quantity of charge of a toner having a small particle size would have selected the features from Diamond and Ohno and combined them with the Konya absent knowledge of the claimed invention. Because the only reason or suggestion to combine Konya with Diamond and Ohno comes from Applicants' disclosure, the rejection is improper and should be withdrawn.

Although Konya discloses obtaining a developer "which is improved in fluidity, cleanability, and uniform and stable charging" (Column 13, Lines 41-43), the uniform and stable charging of Konya means charging stability against continuous use rather than charging stability against environmental fluctuations. Konya neither discloses nor suggests charging stability against environmental fluctuations. Konya evaluates charging stability by printing 10,000 sheets of paper (Column 10, Lines 49-67). However, no environmental conditions in the evaluation process are disclosed. It is reasonable to assume that Konya evaluates charging stability in such conditions wherein the toner surface is not influenced by humidity fluctuation, that is, in constant environmental conditions. Therefore, the technical meaning of charging stability as disclosed by Konya is completely different from the charging stability against environmental fluctuations of the present invention. Even if the charging stability is good in printing 10,000 sheets of paper as disclosed by Konya, results of such an evaluation do not mean or suggest the charging stability against environmental fluctuations of the present invention, as clearly shown in Comparative examples 4 and 6 of the present specification.

Furthermore, Applicants respectfully submit that Konya in view of Diamond and further in view of Ohno does not disclose or suggest a toner comprising, *inter alia*,

hydrophobic inorganic fine particles selected from the group consisting of silica, titanium oxide, alumina, zinc oxide, and mixtures thereof, as recited in claim 1.

In fact, Konya uses composite oxide fine particles to avoid segregation problems associated with plural kinds (*e.g.*, titania and silica) of fine particles. (Column 1, Line 53 – Column 2, Line 4). Thus, it can be said that Konya teaches away from use of an external additive in addition to composite oxide fine particles.

Claims 2, 4, 5, 7-11, 14, 15 and 20-27 recite additional features of the invention and are allowable for the same reasons discussed above with respect to claim 1 and for the additional features recited therein.

Reconsideration and withdrawal of the rejection of claims 2, 4, 5, 7-11, 14, 15 and 20-27 over Konya in view of Diamond and further in view of Ohno is respectfully requested.

Claim 28

Independent claim 28 recites a toner for forming a full color image comprising toner particles that are manufactured by a wet granulating method and contain a binder resin and a colorant and composite oxide fine particles having a specific surface area of not more than $300 \text{ m}^2/\text{g}$, wherein each of the composite oxide fine particles contains at least two metal atoms selected from metals of the group consisting of Si, Ti, Zr, Fe, Nb, V, W, Sn and Ge, wherein the composite oxide fine particles is externally added to the toner particles, and the toner particles have an average degree of roundness of not less than 0.950.

As noted above, the Examiner has failed to identify where in the prior art one of ordinary skill would have found a disclosure or suggestion which would have led him to make the proposed modification. The absence of particular findings as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected the

components for combination in the manner claimed in support of the rejection of claim 28 renders the rejection improper.

As further noted above, the Examiner has not show that the skilled artisan confronted with the problem of degradation in charging stability, with respect to environmental fluctuations and continuous use, as a result of a required high quantity of charge of a toner having a small particle size would have selected the features from Diamond and Ohno and combined them with the Konya absent knowledge of the claimed invention. Because the only reason or suggestion to combine Konya with Diamond and Ohno comes from Applicants' disclosure, the rejection is improper and should be withdrawn.

As additionally noted above, Although Konya discloses obtaining a developer "which is improved in fluidity, cleanability, and uniform and stable charging" (Column 13, Lines 41-43), the uniform and stable charging of Konya means charging stability against continuous use rather than charging stability against environmental fluctuations. Konya neither discloses nor suggests charging stability against environmental fluctuations. Konya evaluates charging stability by printing 10,000 sheets of paper (Column 10, Lines 49-67). However, no environmental conditions in the evaluation process are disclosed. It is reasonable to assume that Konya evaluates charging stability in such conditions wherein the toner surface is not influenced by humidity fluctuation, that is, in constant environmental conditions. Therefore, the technical meaning of charging stability as disclosed by Konya is completely different from the charging stability against environmental fluctuations of the present invention. Even if the charging stability is good in printing 10,000 sheets of paper as disclosed by Konya, results of such an evaluation do not mean or suggest the charging stability against environmental fluctuations of the present invention, as clearly shown in Comparative examples 4 and 6 of the present specification.

Reconsideration and withdrawal of the rejection of claim 28 over Konya in view of Diamond and further in view of Ohno is respectfully requested.

Claim 30

New dependent claim 30 recites, "The toner according to claim 28, wherein hydrophobic inorganic fine particles selected from the group consisting of silica, titanium oxide, alumina, zinc oxide, and mixtures thereof are also added externally to the toner particles."

Further to the arguments above with regard to claim 28, Applicants respectfully submit that Konya in view of Diamond and further in view of Ohno does not disclose or suggest a toner comprising, *inter alia*, hydrophobic inorganic fine particles selected from the group consisting of silica, titanium oxide, alumina, zinc oxide, and mixtures thereof, as recited in claim 30.

As noted above with regard to claim 1, Konya uses composite oxide fine particles to avoid segregation problems associated with plural kinds (*e.g.*, titania and silica) of fine particles. (Column 1, Line 53 – Column 2, Line 4). Thus, it can be said that Konya teaches away from use of an external additive in addition to composite oxide fine particles.

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Claim 29 stand rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Konya in view of the Diamond and further in view of Ohno, and further in view of U.S. Patent No. 6,967,070 ("Nakamura"). The rejection is respectfully traversed.

Nakamura, cited as allegedly disclosing "a wax that is usefully included in a toner" (Official Action, Page 5), does not cure the above-noted deficiencies of Konya, Diamond, and Ohno. Accordingly, withdrawal of this ground of rejection is respectfully requested.

Conclusion

In view of the above amendments and remarks, it is respectfully submitted that all of the claims are allowable and the entire application is in condition for allowance.

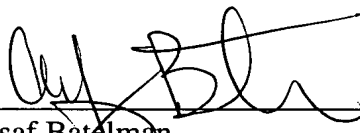
Should the Examiner believe that anything further is necessary to place the application in condition for allowance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

BUCHANAN INGERSOLL & ROONEY PC

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